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IN THE UNITED STATES DISTRICT COURT  
FOR THE CENTRAL DISTRICT OF CALIFORNIA  
SOUTHERN DIVISION

Plaintiff,

KEATING DENTAL ARTS, INC.

AND RELATED COUNTERCLAIMS.

**REPLY MEMORANDUM OF  
POINTS AND AUTHORITIES  
IN SUPPORT OF  
DEFENDANT'S MOTION FOR  
SUMMARY JUDGMENT  
CANCELING GLIDEWELL'S  
TRADEMARK REGISTRATION**

Honorable David O. Carter

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1                   **I. INTRODUCTION AND SUMMARY OF ARGUMENT**

2           Glidewell has failed to present sufficient admissible evidence for a  
3 reasonable jury to find that BruxZir is a valid mark for zirconia dental crowns  
4 intended for bruxers. The undisputed evidence establishes that the primary  
5 significance of BruxZir to dentists and dental labs is to describe the *type of*  
6 *crown* rather than identify Glidewell. Thus BruxZir is generic as a matter of  
7 law. At the very least, the mark is merely descriptive and Glidewell has not  
8 satisfied its burden of proving secondary meaning.

9           Glidewell own videos and testimony establish that BruxZir is  
10 phonetically equivalent to “bruxer,” the intended user of Glidewell’s product.  
11 Because Glidewell adopted a misspelling of the generic name for its product’s  
12 user no amount of advertising or sales can turn it into a protectable trademark.

13           Glidewell evidence in opposition consists of (1) testimony from seven of  
14 its own dentist customers, “surprise” witnesses never identified during  
15 discovery, (2) an expert opinion from a law professor, David Franklyn, who  
16 formed his opinions regarding the BruxZir mark without speaking to a single  
17 dentist, (3) an opinion from Dr. Goldstein, a dentist expert never disclosed in  
18 discovery, and (4) testimony from several Glidewell employees relating  
19 opinions and alleged conversations with dentists touring Glidewell’s facility or  
20 asking questions after Glidewell presentations. Such evidence is not probative  
21 and is inadmissible, particularly in view of the Court’s denial of Glidewell’s *Ex*  
22 *Parte* attempt to extend discovery deadlines. (DOC #74).

23           If not generic, BruxZir is merely descriptive and still not protectable  
24 because Glidewell has failed to establish secondary meaning. BruxZir does not  
25 require “multistep reasoning” by dentists to know what it is. Glidewell’s own  
26 witnesses testified that “it stands for bruxism and zirconia”; “it’s a crown for  
27 bruxers”; “if you see brux or you identify somebody with bruxism, think of  
28 zirconium. So we put brux and zir together.”

1 The BruxZir registration has no presumption of secondary meaning  
 2 because Glidewell did not submit secondary meaning evidence to the  
 3 Trademark Examiner. Glidewell chose not to conduct a survey and responded  
 4 “None” to Keating’s discovery request for such survey evidence. Glidewell’s  
 5 advertising promotes “BruxZir” as a *type of crown* for bruxers, not a source, and  
 6 Glidewell failed to produce any admissible evidence of the effect of its  
 7 advertising on the relevant consumers. Glidewell’s legal expert testified that he  
 8 **had never spoken to a dentist except regarding his own teeth and his own**  
 9 **bruxer crown.** He also ignored or was unaware of much of the third party  
 10 evidence submitted by Keating, including evidence of third party use and  
 11 registrations of marks including “brux” and “bruxer” that predate Glidewell’s  
 12 mark. (Eggleston Decl., Ex. 67 at 3-5; Boatright Decl., Ex. A ¶ 78).

13 Thus, Keating has satisfied its burden of rebutting the presumption of  
 14 validity by a preponderance of the evidence. In contrast, Glidewell has  
 15 woefully failed to meet its burden of establishing a valid protectable mark, and  
 16 the BruxZir registration should be canceled.

## 17 **II. ARGUMENT**

### 18 **A. The BruxZir Registration Is Invalid And Should Be Canceled**

#### 19 **1. Keating’s Evidence Rebutts Presumption of Validity**

20 Keating has submitted more than a preponderance of evidence to rebut the  
 21 presumption of validity of the BruxZir trademark registration.<sup>1</sup> Thus, the  
 22 evidentiary presumption created by the registration has “burst” and Glidewell has  
 23 the burden of proving validity in order to survive summary judgment. *Zobmondo*  
 24 *Entm’t, LLC v. Falls Media, LLC*, 602 F.3d 1108, 1115 (9th Cir. 2010) (citing *Tie*

25  
 26 <sup>1</sup> Keating has presented the Court with evidence in support of the present motion  
 27 (DOC ##085, 087, 087-1, 89, 91-110), in support of Keating’s co-pending  
 28 motion for summary judgment of non-infringement (DOC #084), and in  
 opposition to Glidewell’s motions for summary judgment (DOC ##75-77, 83-  
 85, 87, 89, 91-110, 75-77, 88-89, 84, 86, 91-110, 112, 115-124, 128).

1 *Tech Inc. v. Kinedyne Corp.*, 296 F.3d 778, 783 (9th Cir. 2002)); *CG Roxane LLC*  
 2 *v. Fiji Water Co. LLC*, 569 F. Supp. 2d 1019, 1030 (N.D. Cal. 2008).

3 The presumption afforded a registered trademark assumes that the PTO  
 4 has reviewed the facts upon which to render a classification of  
 5 suggestiveness/inherent distinctiveness, rather than genericness or  
 6 descriptiveness. *See Zobmondo Entm't*, 602 F.3d at 1121 (“[d]eference to the  
 7 PTO’s classification decision is sensible because the PTO has special expertise  
 8 that we lack on this fact-intensive issue.”).

9 No such facts were before the Examiner of Glidewell’s application for  
 10 BruxZir. The Examiner failed to follow the usual procedures of asking if the  
 11 term had any meaning in the industry. (TMEP §§ 814 and 1209.2; Keating SOF  
 12 DOC #087-1 ¶¶ 90-91,94; Boatright Decl., Ex. A ¶ 44). The Examiner also  
 13 failed to conduct an Internet search or at least consult Glidewell’s website in  
 14 accordance with usual practice. (Boatright Decl., Ex. B; Boatright Decl., Ex. A  
 15 ¶¶ 39, 34, 42, 44-47; TMEP § 710.01(b) Internet Evidence (“The examining  
 16 attorney should check applicant’s own website for information about the  
 17 goods/services); *see In re Promo Ink*, 78 U.S.P.Q.2d (BNA) 1301, 1303 (TTAB  
 18 2006); *In re Reed Elsevier Props.*, 482 F.3d 1376, 1379 (Fed. Cir. 2007).  
 19 Keating knew the Examiner was not a dentist and would not be aware that  
 20 “brux” means teeth grinding and “zir” means zirconia. (Keating SOF DOC  
 21 #087-1 ¶¶ 4-5, 60). The Examiner was also unaware that BRUXZIR is  
 22 phonetically identical to “bruxer,” the user of Glidewell’s dental crowns  
 23 (Keating SOF DOC #087-1 ¶¶ 47-53, 6-8), as referenced in Glidewell’s  
 24 marketing materials (“ideal” for bruxers). (SOF DOC #087-1 ¶¶ 40, 44-46).

25 **B. Glidewell Has Failed To Satisfy Its Burden On Summary Judgment**  
 26 **Of Proving A Protectable Mark**

27 It is settled law that registered marks may become generic and subject to  
 28 cancellation at any time. *Yellow Cab Co. v. Yellow Cab of Elk Grove, Inc.*, 419

1 F.3d 925, 928 (9th Cir. 2005); *Surgicenters of America, Inc. v. Medical Dental*  
2 *Surgeries Co.*, 601 F.2d 1011 (9th Cir. 1979); 15 U.S.C. §§ 1064(3), 1065(4);  
3 *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985) (“a  
4 registered mark may be canceled at any time on the grounds that it has become  
5 generic”); *CG Roxane*, 569 F. Supp. 2d at 1026.

6 Glidewell did not submit any survey evidence to establish that the  
7 *primary significance* of the BruxZir mark is to identify Glidewell and not the  
8 product itself. Other than the mere fact of its registration, the only admissible  
9 evidence that Glidewell presents to the Court consists of statements from its  
10 own employees. Such statements from interested witnesses are insufficient to  
11 satisfy Glidewell’s burden on summary judgment. *Filipino Yellow Pages, Inc.*  
12 *v. Asian Journal Publ’ns, Inc.*, 198 F.3d 1143, 1152 (9th Cir. 1999) (‘trademark  
13 law is skeptical of the ability of an associate of a trademark holder to transcend  
14 personal biases to give an impartial account of the value of the holder’s mark.’)  
15 (citing *Self-Realization*, 59 F.3d at 910). (citing *Norm Thompson Outfitters, Inc.*  
16 *v. GM Corp.*, 448 F.2d 1293, 1297 (9th Cir. 1971) (testimony from persons  
17 closely associated with the plaintiff does not adequately reflect the views of the  
18 buying public)); *In re Redken Labs.*, 170 U.S.P.Q. (BNA) 526, 529 (TTAB  
19 1971) (“The statement by applicant’s president that the [mark] has become  
20 distinctive of applicant’s services is, at best, a self-serving statement which  
21 standing alone carries little weight in persuading us that the term in question  
22 functions as an indication of origin.”); *Self-Realization Fellowship Church v.*  
23 *Ananda Church of Self-Realization*, 59 F.3d 902, 910 (9th Cir. 1995)  
24 (declarations from trademark plaintiff’s employees and wholesalers had “little  
25 probative value regarding the assessment of consumer perception).

26 Glidewell has therefore failed to submit sufficient evidence to satisfy its  
27 burden on summary judgment.

28 ///

1           **1.     BruxZir Is A Misspelling of Bruxer**

2           One need only watch Glidewell's promotional videos and videorecorded  
3 testimony of Glidewell's witnesses to hear the phonetic equivalency of BruxZir  
4 with bruxer. (Van Hoosear Decl. DOC #110, Ex. V-1, V-2, V-3, V-4).  
5 Glidewell admits that "bruxer" is the generic name for a person who bruxes and  
6 the intended user of Glidewell's BruxZir crowns. (Keating SOF DOC #087-1  
7 ¶¶ 39-46). As the phonetic equivalency of, and a misspelling of the generic  
8 name for the intended user, the mark is generic as a matter of law. *See*  
9 MCCARTHY ON TRADEMARKS, 4TH EDITION, § 12:38, "Misspelling of generic  
10 terms"; *Nupla Corp. v. IXL Mfg. Co.*, 114 F.3d 191, 196 (Fed. Cir. 1997)  
11 (affirming Central District of California conclusion as a matter of law that  
12 plaintiff's registered mark CUSH-N-GRIP is invalid as a generic misspelling of  
13 "cushion grip" for cushioned tool handles); *Rudolph Int'l v. Realys Inc.*, 482  
14 F.3d 1195, 1198 (9th Cir. 2007) (citing *Nupla Corp.*, 114 F.3d 191 ("cush-  
15 n'grip' is generic adjective for cushion-gripped tools"); *Miller Brewing Co. v.*  
16 *G. Heileman Brewing Co.*, 561 F.2d 75, 79-81 (7th Cir. 1977) ("Lite Beer"  
17 phonetic equivalent to generic "light beer"); *Soweco, Inc. v. Shell Oil Co.*, 617  
18 F.2d 1178, 1186 n.24 (5th Cir. 1980) ("Plaintiff's using the phonetic equivalent  
19 of the generic term 'larvicide' in its mark 'Larvacide,' i.e., misspelling it, does  
20 not render the mark protectable." (citing *Miller Brewing*, 561 F.2d at 79-81)  
21 ("Using the phonetic equivalent of a common descriptive word, i.e., misspelling  
22 it, is of no avail."). Using a misspelling of the intended user name also renders a  
23 mark generic. *Retail Servs. v. Freebies*, 364 F.3d 535, 547 (4th Cir. 2004).

24           **a.     BruxZir Identifies A Type Of Crown For Bruxers, Not A**  
25           **Source**

26           Keating submitted substantial evidence that dentists and dentist  
27 professionals identify the primary significance of the term BruxZir as a type of  
28 crown for bruxers, not Glidewell as the source. (*See, e.g.,* Jankowski Decl.,

1 Exs. 36-43; Eggleston Decl., Ex 65 at 14-18; Ex. 66 at 3-7; Exs. 98, 107; Belton  
 2 Decl. ¶¶ 9-11; Brady Decl. ¶¶ 9-12; Campbell Decl. ¶¶ 10-12; Colleran Decl. ¶¶  
 3 10-12; Jacquinet Decl. ¶¶ 9-11; Murphy Decl. ¶¶ 8-11; Myers Decl. ¶¶ 10-11;  
 4 Nussear Decl. ¶¶ 9-11; Richardson Decl. ¶¶ 9-12; Scott Decl. ¶¶ 9-11; Stephens  
 5 Decl. ¶¶ 10-12; Sweet Decl. ¶¶ 8-10; Tobin Decl. ¶¶ 9-11, Frattura Decl. ¶¶ 7-9,  
 6 12, 18; Request for Judicial Notice Ex. A-N).

7 The evidence of long-standing use of “bruxer” to refer to a bruxism  
 8 patient (the intended user of Glidewell’s BruxZir crowns), corroborates this  
 9 understanding in the industry. (Keating SOF DOC #087-1 ¶¶ 6-8, 60-62). In  
 10 addition, the evidence from Glidewell and other dental labs reveals that the term  
 11 Bruxzir is widely used to identify a type of product (a zirconia crown for  
 12 bruxers) rather than a source of goods. This includes prescription forms and  
 13 advertising from dental labs, including Glidewell and other competing dental  
 14 labs, (Eggleston Decl., Exs. 136-137). These dental labs are not using the term  
 15 BruxZir as a brand, but rather as a reference to a type of product: an all zirconia  
 16 crown, commonly used for bruxers.

17 Glidewell cites to no probative evidence that dentists around the U.S.  
 18 view the BruxZir mark as a source of goods. Its employee declarations are not  
 19 probative and the seven Glidewell dentist customer declarations are  
 20 inadmissible as the witnesses were never disclosed during discovery.  
 21 Accordingly, such evidence cannot support Glidewell’s opposition on this  
 22 motion. Fed. R. Civ. P. Rule 37(c).

23 Glidewell’s legal expert, Professor Franklyn’s testimony is equally  
 24 inadmissible. He formed his opinion without speaking with any dentists. (2nd  
 25 Jankowski Decl., Ex. 153 (Franklyn Dep. Tr.), at 133:6-8 (“**I have not spoken**  
 26 **to any dentists about anything other than my own teeth and my own bruxer**  
 27 **crown.**”) His subsequent declarations, based on untimely rebuttal reports  
 28 discussing interviews with previously undisclosed dentist witnesses are



1 inadmissible. Fed. R. Civ. P. Rule 37(c). His legal opinions are also  
 2 inadmissible pursuant to Fed. R. Evid. Rule 701, 702. (*See* Keating's  
 3 Objections to Evidence, DOC #120). Likewise, Dr. Goldstein's declaration is  
 4 inadmissible as he was never disclosed during discovery and did not submit a  
 5 timely expert report. (Fed. R. Civ. P. Rule 37(c); *see* Keating's Objections to  
 6 Evidence, DOC #121 and Objections to Supplemental Evidence).

7 Glidewell relies on the mere fact that it uses BruxZir in its marketing to  
 8 dentists across the U.S. (Opp. at 23-25), and attempts to equate its mark with  
 9 several famous marks, such as Ford and Coca Cola. (Opp. at 11). Such famous  
 10 marks are arbitrary or fanciful, with no descriptive meaning of the goods or  
 11 intended users of the products. In stark contrast, Glidewell chose a mark that  
 12 dentists immediately view as generic, or at least highly descriptive, for the product,  
 13 and Glidewell has submitted no probative evidence of the *primary significance* of  
 14 its mark in the minds of relevant consumers. Glidewell's sales and advertising  
 15 efforts, by themselves do not establish that relevant purchasers view BruxZir as  
 16 identifying Glidewell as *the source*, rather than *a type of crown* for bruxers.

## 17 **2. Pre and Post May 2011 Evidence Shows Genericness**

18 Glidewell argues that portions of Keating's voluminous evidence of  
 19 generic use is not admissible, because it is not dated prior to Keating's entrance  
 20 into the market in May 2011 with its KDZ Bruxer product. (Opp. p. 7-8, 14-16).  
 21 While Glidewell is attempting to exclude admissible evidence existing post  
 22 April 2011 based on an overly rigid application of Ninth Circuit law,<sup>2</sup> the  
 23 evidence of genericness prior to and including May 2011 is overwhelming.

24  
 25 <sup>2</sup> For example, courts may consider surveys conducted during the  
 26 litigation, and after the defendant entered the market with its allegedly  
 27 infringing mark. *See Classic Foods Int'l, Corp., v. Kettle Foods, Inc.*, 468 F.  
 28 *Supp. 2d* 1181 (C.D. Cal. 1181); *Nightlight Sys., Inc., v. Nitelites Franchise*  
*Sys., Inc.*, No. 1:04-CV-2112, 2007 WL 4563873 (N.D. Ga. 2007); *see also*  
*Burger King Corp. v. Pilgrim's Pride Corp.*, 705 F. Supp. 1522, 1525 (S.D. Fla.  
 1988).

1 At the end of March 2011, Keating drafted a form letter to send to all of  
 2 its current clients announcing changes in its fee schedule as well as a new  
 3 “Family of Products” which included the KDZ Bruxer, KDZ Ultra, and KDZ  
 4 Max. (Keating Decl., Ex. F). The letter informed Keating’s clients that the  
 5 changes were to be effective in May 2011. (*Id.*) While Keating had sold some  
 6 all zirconia crowns prior to May 2011, those were sales only to existing  
 7 customers to help Keating test its new product and were not made available to  
 8 the general public. (2nd Mangum Decl., Ex. 160 (Donich Dep. Tr.), at 8:18-  
 9 9:3). The first official sales of the KDZ Bruxer product occurred on May 10,  
 10 2011. (*See* Mangum Decl., Ex. 53 (Brandon Dep. Tr.), at 36:1-16; *see also*  
 11 Mangum Decl., Ex. 53 (Brandon Dep. Tr.), at 25:25-26:20.

12 There is voluminous evidence prior to May 2011 showing (a) use of  
 13 “bruxer” to identify a bruxism patient in U.S. Patents dating back as far as the  
 14 1980’s (*see* Keating’s Req. for Jud. Notice, Exs. A-F); (b) use of “bruxer” to  
 15 identify bruxism patients in dental industry journals dating back to the 1990’s  
 16 (*see* Eggleston Decl., Exs. 68-78); (c) third party trademark registrations  
 17 including “brux” and “zir” for dental products that pre-date Glidewell’s mark  
 18 (*see* Keating’s Req. for Jud. Notice, Exs. F-I; (d) third party uses of “brux,”  
 19 “bruxer” and “zir” in connection with identification or description of similar  
 20 products (*see* Eggleston Decl., Exs. 93-94, 96, 99-106, 108-114, 117, 119-135;  
 21 Jankowski Decl., Exs. 24, 27-32, 34, 37-39, 42-43); (e) evidence of Dentists’  
 22 and dental professionals’ use of “bruxer” to refer to bruxism patients.  
 23 (Jankowski Decl., Ex. 4 (DiTolla Dep. Tr.), at 186:20-21; Mangum Decl., Ex.  
 24 50 (Shuck Dep. Tr.), at 199-200; Eggleston Decl., ¶ 16; Eggleston Decl., Ex 65,  
 25 at 12-14; Jankowski Decl., Ex. 1 at 5 (Interrogatory No. 2); Jankowski Decl.,  
 26 Ex. 3 at 8 (Request for Admission No. 9; Campbell Decl., ¶¶ 10, 12; Colleran  
 27 Decl. ¶ 7; Jacquinet Decl., ¶ 11; Myers Decl. ¶ 11; Nussear Decl. ¶ 11; Scott  
 28 Decl. ¶ 11; Stephens Decl. ¶¶ 10, 12; Sweet Decl., ¶ 8).



1 In addition, Glidewell admits that the mark BRUXZIR was adopted, in  
 2 part, to connote a product that is useful for bruxers and that the product is  
 3 composed of zirconia. (Jankowski Decl., Ex. 3 at 6). Glidewell also  
 4 prominently promoted its new all-zirconia crown as “ideal” for bruxer patients  
 5 in its marketing materials and in technical articles authored by its Vice President  
 6 of R&D, Mr. Carden. (Mangum Decl., Ex. 50 (Shuck Dep. Tr.), at 87-88, 176-  
 7 178; Jankowski Decl., Ex. 8; Ex. 10 at 3, 12, 23, 26; Ex. 11 at 1, 3, 5-6; Ex. 12;  
 8 Ex. 13; Ex. 15-17; Eggleston Decl., Exs. 79-84).<sup>3</sup>

9 Furthermore, the evidence of continuing generic use post May 2011  
 10 corroborates the generic understanding of the term “bruxzir” in the industry.  
 11 (See e.g., Frattura Decl., Ex. A p 1-9, 11, 18; Belton Decl., Ex. A; Brady Decl.,  
 12 Ex. A; Campbell Decl., Ex. A; Colleran Decl. Ex. A; Jacquinet Decl., Ex. A;  
 13 Murphy Decl., Ex. A; Myers Decl., Ex. A; Richardson Decl., Ex. A; Scott Decl.,  
 14 Ex. A; Stephens Decl., Ex. A; Sweet Decl., Ex. A; Tobin Decl., Ex. A;  
 15 Eggleston Decl., Exs. 112, 116, 118, 120; Keating SOF DOC #087-1 ¶¶ 6, 60,  
 16 61, 62; Jankowski Decl., Exs. 36-44).

17 Glidewell’s argument that BruxZir is not generic because its phonetic  
 18 equivalent, “bruxer,” is the generic term for the intended user, rather than the  
 19 crown itself is meritless. Such a “razor-thin” distinction is insignificant. *Retail*  
 20 *Servs.*, 364 F.3d at 547 (“even though defendants do not directly distribute free  
 21 products or “freebies,” their business nonetheless revolves around “freebies” in  
 22 the generic sense of the word). Here, Glidewell’s distinction that BruxZir’s  
 23 phonetic analogue, “bruxer,” is generic for the intended user rather than a crown

24 ///

25  
 26 <sup>3</sup> Contrary to Glidewell’s argument (Opp. at 18) the absence of the term  
 27 “bruxer” from the dictionary is not determinative. *Filipino Yellow Pages*, 198  
 28 F.3d at 1148; *Nartron Corp. v. STMicroelectronics, Inc.*, 305 F.3d 397, 407 (6th  
 Cir. 2002) cert denied, 538 U.S. 907, 123 S Ct. 1486, 155 L. Ed. 228 (2003)  
 (numerous terms have been found generic despite absence from the dictionary).

1 is not persuasive. Glidewell's business revolves around selling the BruxZir  
2 crown for use by bruxers.

3 **3. Keating's Alternative Argument Of Mere Descriptiveness Is**  
4 **Not An Admission Of Validity**

5 Glidewell's argument that Keating's alternative argument of mere  
6 descriptiveness somehow constitutes an admission of non-genericness is entirely  
7 meritless. Alternative arguments do not constitute admissions. *Maloney v.*  
8 *Scottsdale Ins. Co.*, 256 Fed. Appx. 29, 31 (9th Cir. 2007); Fed. R. Civ. P.  
9 8(d)(2)-(3). The court's ability to find a mark generic is certainly not abrogated  
10 by an alternative argument that the mark is descriptive. *See Filipino Yellow*  
11 *Pages*, 198 F.3d 1143 (holding mark generic after considering alternative  
12 genericness and descriptiveness arguments); *CG Roxane*, 569 F. Supp. 2d 1019  
13 (holding mark generic after considering alternative genericness and  
14 descriptiveness arguments). Moreover, the argument that a mark contains a  
15 descriptive portion and therefore cannot be generic has consistently been  
16 rejected by the courts. *Classic Foods Int'l Corp. v. Kettle Foods, Inc.*, 468 F.  
17 Supp. 2d 1181 (C.D. Cal. 2007) (citations omitted). "[A]ssuming that any  
18 element of description within a mark automatically precludes that mark from  
19 being found to be generic is factually and legally inaccurate. . ." *Id.* A generic  
20 designation is simply the "ultimate in descriptiveness." *Id.* Therefore,  
21 Glidewell's argument is entirely baseless.

22 **4. Glidewell Mischaracterizes Keating Evidence**

23 As a sign of desperation, Glidewell resorts to mischaracterizing the  
24 testimony of Keating's witnesses to argue that their awareness of Glidewell's  
25 registration and actions since the filing of the suit somehow is evidence of the  
26 validity of Glidewell's mark. (Opp., pp. 1, 6-7).

27 Under Fed. R. Evid. 407, evidence of actions taken by defendants to  
28 reduce potential liability cannot be relied upon as an admission. *Interactive*

1 *Health LLC v. King Kong USA, Inc.*, CV06-1902, 2008 U.S. Dist. LEXIS  
 2 123559, \*20 (C.D. Cal. July 24, 2008) (excluding evidence offered by plaintiffs  
 3 of defendants' sale of different products in lieu of accused models); *Avery*  
 4 *Dennison Corp. v. Acco Brands, Inc.*, CV99-1877, 1999 U.S. Dist. LEXIS  
 5 21464, 22 (C.D. Cal. Oct. 12, 1999) (excluding evidence offered by plaintiffs of  
 6 defendant's change in its packaging).

7 After being sued by Glidewell, Keating initiated a policy of calling  
 8 dentists who wrote "Bruxzir" or variations thereof on their prescription forms  
 9 submitted to Keating to (1) educate the dentists as to the existence of BruxZir as  
 10 a trademark of a competing dental lab, and (2) to confirm that the dentists  
 11 wanted Keating's all-zirconia crown, and not another dental lab's product.  
 12 (Keating SOF DOC #087-1 ¶¶ 72-75; Mangum Decl., Ex. 53 (Brandon Dep.  
 13 Tr.), at 47:12 – 48:20). As part of its policy, Keating had its employees inform  
 14 each dentist who wrote "BruxZir," or variations thereof on their prescription  
 15 forms that a competing dental lab has a registered mark in the name BruxZir.  
 16 (Keating SOF #087-1 ¶ 74 DOC). That is a factual statement, not a party  
 17 admission as to the validity of Glidewell's registration.

18 Every time, the dentists confirmed they were indeed ordering Keating's  
 19 product and were not confused in any way. (Keating SOF #087-1 ¶ 75 DOC,  
 20 Belton Decl., ¶¶ 9-11; Brady Decl., ¶¶ 9-11; Campbell Decl., ¶¶ 10-12; Colleran  
 21 Decl. ¶¶ 10-12; Jacquinet Decl., ¶ 9; Murphy Decl., ¶ 11; Myers Decl., ¶¶ 9;  
 22 Nussear Decl., ¶¶ 9-11; Richardson Decl., ¶ 10-12; Scott Decl., ¶¶ 9-11;  
 23 Stephens Decl., ¶¶ 10-12; Sweet Decl., ¶¶ 8-10; Tobin Decl., ¶¶ 9-11). Indeed,  
 24 the fact that Keating had to tell the dentists that a competitor owned the mark  
 25 "BruxZir" just emphasizes that those dentists were not aware it was a trademark.  
 26 Such evidence shows that dentists view the term generically as the name of the  
 27 *type of crown* and not as an indication that Glidewell is the source.

28 ///

1 Although Mr. Brandon did testify that he knew BruxZir was a tradename  
 2 of Glidewell, he also stated he could not testify as to what Dr. Nussear  
 3 understood when he ordered a BruxZir zirconia crown from Keating. Mr.  
 4 Brandon stated that he should have called the doctor to clarify because Keating  
 5 was “getting sued over it.” (Mangum Decl., Ex. 53 (Brandon Dep. Tr.), at  
 6 48:17-20). So Mr. Brandon’s comment was directed to Keating’s policy after  
 7 this suit was filed of calling dentists who wrote “bruxzir” on their prescription  
 8 forms. It did not relate to any action by Keating in May 2011 as Glidewell is  
 9 now claiming.

10 Glidewell severely mischaracterizes Mr. Keating’s deposition testimony  
 11 (Opp. p. 1, 6). On the pages cited, Mr. Keating testified that “Doctors have been  
 12 using the name “bruxer” for a strong crown forever, be it gold, be it zirconia.  
 13 Now it’s kind of a generic name for an all-full model of the crown. You can see  
 14 it on the Internet and everything else for bruxer crowns. . . . I just think it’s for  
 15 grinding patients, a full contoured monolithic zirconia crown for bruxers.”  
 16 (2nd. Jankowski Decl., Ex. 145 (Keating Dep. Tr.) DOC #125, at 113-115; App.  
 17 Ev. 85). When Mr. Keating stated the word BruxZir is not “used in any other  
 18 way in the industry” he was referencing his responses to the entire line of  
 19 questions, including his preceding testimony that the mark was a generic term in  
 20 the industry for full monolithic zirconia crowns. (*Id.*)

21 **5. Keating Internal Documents Do Not Establish That Glidewell’s**  
 22 **Mark Is Protectable**

23 Glidewell references two documents that Keating’s personnel generated  
 24 referencing the BruxZir mark as a “proprietary name.” (Opp. p. 6). Again,  
 25 these documents, generated on October 18, 2011 and March 8, 2012,  
 26 respectively, reference Keating’s policy after this suit was filed of calling  
 27 dentists to confirm that they wished to order a Keating KDZ Bruxer crown. It  
 28 does not establish that Glidewell has a protectable trademark. Rather, as

mentioned above, such efforts of subsequent remedial measures taken by a defendant to reduce potential liability are inadmissible. (Fed. R. Evid. 407).

**6. Evidence Of Generic Use From Showcase Dental Lab**

Glidewell mischaracterizes the evidence offered in Ms. Frattura's declaration. First Ms. Frattura herself testifies that Showcase Dental Lab used the term "Zir-Bruxer" starting at the end of 2010 because "it readily described the product for which it was named. . . . The 'Bruxer' suffix identified that the crown was an all-zirconia crown . . . strong enough to be used as a bruxer crown, or a crown for bruxer patients. . . ." (Frattura Decl. ¶ 12). Additionally, while some of the prescription forms Ms. Frattura attached are for orders placed in 2012, and show dentists' continued use of bruxzir as a generic term, many of them show such generic use in 2011 and even 2010. For example, an order from September 2010 asks for a "BRUX zirconia" crown, two orders from May 2011 ask for "Bruxzir crowns" and "Brux zirconia," a form from June 2011 states "Bruxzir" and "Bruxeer," and two more in August 2011 state "Bruxir" and "Bruxzir." (Frattura Decl., Ex. A at 10, 11, 14, 16-18).

**7. Undisclosed Glidewell Customer/Dentists' Testimony And Untimely Expert Testimony Is Inadmissible**

During discovery, Glidewell failed to identify (1) any third party dentists to testify regarding their understanding of the BruxZir mark; (2) any survey data regarding third party dentists' understanding of the mark; or (3) any expert witnesses to testify about survey data or dentists' understanding of the mark. Glidewell now relies upon (1) seven declarations from dentist/customers of Glidewell first noticed by Glidewell as witnesses seventeen minutes before Midnight on Discovery Cutoff, October 29 2012 (*see* App. Evid. Exs. A-F & Q); (2) expert opinion from Glidewell's in-house dentist, Dr. DiTolla, notice of which was received by Keating nine minutes before Midnight on Discovery Cutoff, October 29, 2012; and (3) three expert reports received by Keating

1 seven minutes before Midnight on Discovery Cutoff, October 29, 2012 (2nd  
2 Jankowski Decl. ¶ 11; 2nd Jankowski Decl., Exs. 148, 150-152).

3 The testimonies of the seven dentist witnesses, who are Glidewell  
4 customers, are inadmissible because they were not disclosed during discovery.  
5 (Fed. R. Civ. P. Rule 37(c)). Moreover, as Glidewell customers, their  
6 testimonies are not probative. *See Filipino Yellow Pages*, 198 F.3d at 1151-52  
7 (citing *Norm Thompson Outfitters*, 448 F.2d at 1297); *Self-Realization*, 59 F.3d  
8 at 910. Likewise, Dr. DiTolla's declaration, based on his untimely designation  
9 as an expert, is inadmissible and not probative as he is a Glidewell employee.

10 Professor Franklyn, a law professor, repeats language from his untimely  
11 rebuttal reports where he claims to have interviewed 10 dentist witnesses who  
12 were not previously disclosed during the discovery period or in his initial report  
13 dated September 15, 2012, or in his deposition on October 12, 2012. Indeed, at  
14 his deposition, Professor Franklyn testified repeatedly that he had never spoken  
15 to a dentist or dental lab in connection with this case and had no experience in  
16 the dental industry. (2nd Jankowski Decl., Ex. 153 (Franklyn Dep. Tr.) at  
17 29:11-17; 44-45; 96-97; 106-107; 133:6-8; 151-152). Thus, the Franklyn  
18 Declarations and untimely rebuttal reports are entirely improper and should be  
19 excluded. Likewise, Dr. Goldstein's declaration is based on an untimely  
20 rebuttal report, and Dr. Goldstein was never disclosed during discovery. Thus,  
21 Dr. Goldstein's declaration should also be excluded. (*See Keating's Objections*  
22 *to Evidence*, DOC #121, and *Objections to Supplemental Evidence* submitted  
23 *herewith*). *See Yeti by Molly, Ltd. v. Deckers Outdoor Corp.*, 259 F.3d 1101,  
24 1106 (9th Cir. 2001); *Jarritos, Inc. v. Reyes*, 345 Fed. Appx. 215, 217 (9th Cir.  
25 2009); *1<sup>st</sup> Source Bank v. First Resource Fed. Credit Union*, 167 F.R.D. 61, 64  
26 (N.D. Ind. 1996); *see also Fu v. Owens*, 622 F.3d 880, 883-84 (8th Cir. 2010).  
27 Professor Franklyn's testimony should also be excluded because his legal  
28 opinions and conclusory testimony are inadmissible under Fed. R. Evid. 701,



1 702. (See Keating's Objections to Evidence DOC #120, and Objections to  
2 Supplemental Evidence submitted herewith).

3 **8. Glidewell Employee Declarations Are Not Evidence of Primary**  
4 **Significance Of Mark To Relevant Consumers**

5 Glidewell's employee declarations (Jim Shuck, Dr. DiTolla, Rudy  
6 Ramirez, Robin Carden, Dr. DiTolla and Robin Bartolo)<sup>4</sup> do not establish, as  
7 required by law, that the *primary significance* of the mark in the minds of the  
8 relevant purchasing public is to identify Glidewell as the source of the product.  
9 Also, such employee declarations are insufficient to defeat Keating's motion for  
10 summary judgment. *Japan Telecom, Inc. v. Japan Telecom Am., Inc.*, 287 F.3d  
11 866, 873 (9th Cir. 2002); *Self-Realization*, 59 F.3d at 910. Such evidence has  
12 "had little probative value . . . to [prove] secondary meaning". (*Id.* at 911).  
13 Furthermore, opinions set forth in these declarations regarding dentists'  
14 perceptions are not probative because, in addition to being hearsay, they fail to  
15 follow rigorous standards required for admissible survey data. See MCCARTHY  
16 ON TRADEMARKS, 4TH EDITION, § 32:158 at 32-341; *M2 Software, Inc. v.*  
17 *Madacy Entm't*, 421 F.3d 1073, 1087 (9th Cir. 2005); *Hodgdon Powder Co. v.*  
18 *Alliant Techsystems, Inc.*, 512 F. Supp. 2d 1178, 1181 (D. Kan. 2007).

19 The testimony is also contrary to the undisputed evidence of widespread  
20 use of "bruxer," "brux" and "zir" to identify types of crowns. The declaration  
21 testimony also contradicts prior deposition testimony and is also inadmissible on  
22 those grounds. *Harris v. Del Taco, Inc.*, 396 F. Supp. 2d 1107, 1111 (C.D. Cal.  
23 2005); *Kennedy v. Allied Mut. Ins. Co.*, 952 F.2d 262, 266 (9th Cir. 1991). (See  
24 Keating's Objections to Supplemental Evidence, submitted herewith).

25 ///

26  
27 <sup>4</sup> Keating has objected to these declarations (see Keating Objections to  
28 Evidence, DOC # 122, and Objections to Glidewell's Supplemental Evidence  
submitted herewith).

1 **C. Glidewell's Generic Use Confirms Genericness Of BruxZir**

2 Glidewell's own generic use of the mark BruxZir is further evidence of  
3 the mark's invalidity.

4 "[C]ourts will also look to the trademark holder's own use of the mark to  
5 determine genericness.' . . . 'This evidence is "relevant because '[a] kind  
6 of estoppel arises when the proponent of [a] trademark use is proven to  
7 have itself used the term before the public as a generic name.'"

8 *CG Roxane*, 569 F. Supp. 2d 1019 (citing *Colt Def. LLC v. Bushmaster*  
9 *Firearms, Inc.*, 486 F.3d 701, 707 (1st Cir. 2007) (citing MCCARTHY ON  
10 TRADEMARKS, 4TH EDITION, § 12:13)); *Rudolph*, 482 F.3d at 1198; *Retail*  
11 *Servs.*, 364 F.3d at 545.

12 Glidewell's own videos use the term 'bruxzir' pronounced identically to  
13 'bruxer' to refer to sold zirconia crowns, often as a noun for the product, not to  
14 identify Glidewell as the source. (Keating SOF DOC #087-1 ¶¶ 47-53, 57, 85).  
15 Additionally, presentations by Glidewell employees establish Glidewell's own  
16 generic use of the term "BruxZir" to identify the product, not the source. Dr.  
17 DiTolla even states "one can even get a couple of BruxZirs put in." (Keating  
18 SOF DOC #087-1 ¶ 58). Such evidence of the owner's generic use "is strong  
19 evidence of genericness." MCCARTHY ON TRADEMARKS, 4TH EDITION, § 12:13.

20 Glidewell's analogy to Coca Cola is misplaced. (Opp. p. 11). Unlike  
21 BruxZir, Coke or Coca is not phonetically equivalent to the person who drinks  
22 Coca Cola. A better analogy is "gold" or "porcelain-fused-to-metal (PFM)" the  
23 two generic designations for the types of crowns to which Glidewell compares  
24 its BruxZir crowns (pronounced "bruxer crowns."), and which Dr. DiTolla in  
25 Glidewell's videos call "a BruxZir," (pronounced "a bruxer"). (DOC #75,76;  
26 Van Hoosear Decl., Exs. V-1, V-2, V-3, V-4, V-5). Thus, the law Glidewell  
27 relies upon for use of famous marks as nouns is completely inapposite. Unlike  
28 those marks, Glidewell chose a mark that is phonetically equivalent to the



generic name bruxer, identifying the intended user, and also admittedly describing characteristics of the product, i.e. use for bruxers or bruxism and zirconia.

**D. Use of BruxZir By “Authorized Labs” Is Not Controlled And Does Not Identify Glidewell As A Source**

Contrary to Glidewell’s statements, the evidence establishes that:

(a) lists of “Authorized BruxZir Labs” list Glidewell as one of many different competitors offering the same type of BruxZir crowns (Jankowski Decl., Ex. 8);

(b) Glidewell’s Rx booklets sent to approximately 120,000 dentists across the country do NOT reference Glidewell as the source (Jankowski Decl., Ex. 10);

(c) Glidewell’s “E-blasts” and letter campaigns “to bring the awareness of the BruxZir brand and its benefits and what makes it better” do not reference Glidewell as the source. (Jankowski Decl., Exs. 7, 10) (here again, Glidewell demonstrates its use of “BruxZir” to refer to a thing, not a source).

In addition, Glidewell’s own witnesses testified that they did not have any license agreements or systems in place for controlling quality of crowns made by the “authorized labs” or the manner in which the “authorized labs” used the BruxZir mark. (Jankowski Decl., Ex. 5 (Bartolo Dep. Tr.), at 63). To become an authorized lab, a dental lab need only buy zirconia milling blanks from Glidewell. (*Id.* at 58-59, 98-99). Glidewell does not review samples of finished crowns made by these labs unless asked to do so by the labs, and Glidewell does not have a monitoring system in place for the labs. (*Id.* at 64). Such “naked licensing” with no quality control results in a mark ceasing to function as a symbol of quality and a controlled source. *Barcamerica Int’l USA Trust v. Tyfield Imps., Inc.*, 289 F.3d 589, 596-97 (9th Cir. 2002) (citing MCCARTHY ON TRADEMARKS, 4TH EDITION, § 18:48).

1 Because of the uncontrolled use of the mark BruxZir by 180 authorized  
 2 labs, the manner in which the mark is used by those labs to describe a type of  
 3 crown, not a source, and the appearance of 180 different competitors, alongside  
 4 Glidewell as just one of the competitors, BruxZir serves no source identifying  
 5 function, and there is no trademark recognition that “inures to the benefit” of  
 6 Glidewell. (Jankowski Decl., Ex. 5 (Bartolo Dep. Tr.), at 46:15-20; Jankowski  
 7 Decl., Ex. 8).

8 **E. Evidence Establishes Widespread Third Party Marks Including**  
 9 **“Brux”, “Zir” And “Bruxer” For Zirconia Crowns**

10 Glidewell asks the Court to ignore its enforcement activities against  
 11 marks that include “Brux,” claiming that the existence of third party “brux”  
 12 marks do not affect the validity of its mark. (Opp. p 25). If that is correct, then  
 13 Glidewell’s registration is not enforceable against third party “brux” marks. As  
 14 Glidewell has repeatedly sent cease and desist letters to owners of such third  
 15 party marks (Jankowski Decl., Ex. 6 (Allred Dep. Tr.) at 213:19-264:13 & Exs.  
 16 19-34), they should certainly be considered in assessing genericness and/or  
 17 descriptiveness of Glidewell’s mark. Moreover, the prevalence of such third  
 18 party use both before Glidewell adopted its mark, and in the short time since  
 19 June 2009, when Glidewell first used its mark, is further evidence that the mark  
 20 cannot be associated with Glidewell as a single source.

21 **F. Widespread Use Of Brux And Zir In Dental Industry Shows Those**  
 22 **Terms Do Not Indicate Source**

23 The widespread third party use of “brux” and “zir” in trademarks for  
 24 similar products shows that relevant consumers do not associate those terms  
 25 with one source. Simply because Glidewell put them together to form a word  
 26 that sounds identical to the generic word “bruxer,” the user of the products  
 27 identified in Glidewell’s registration, cannot bestow Glidewell with valid  
 28 trademark rights.

1 **G. Glidewell's Mark, If Not Generic, Is Merely Descriptive**

2 **1. Dentists Do Not Need Any Mental Leap Of Imagination To**  
 3 **Recognize BruxZir As Meaning Zirconia Crowns For Bruxers**

4 “Words that describe the characteristics of goods, services, or business  
 5 are descriptive. So too are words describing . . . the class of intended  
 6 purchasers.” (RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 14  
 7 (1995); *see also* TMEP § 1209.03(i); Boatright Decl. DOC #94, Ex. A at ¶ 48).  
 8 Glidewell argues that the mark BruxZir is suggestive, requiring dentists to  
 9 engage in multistage reasoning to identify the characteristics of the product that  
 10 are being suggested. (Opp. p. 1, 16, 18). Yet Glidewell cites to no admissible  
 11 probative evidence that dentists viewing the mark find it suggestive. Glidewell  
 12 relies on party statements from Mr. Shuck, Dr. DiTolla, Mr. Ramirez and Mr.  
 13 Bartolo, untimely expert opinion from Dr. Goldstein and Dr. DiTolla, and  
 14 conclusory expert opinion from Mr. Franklyn, a law professor. With the  
 15 exception of Dr. Goldstein, the testimony of these witnesses is not probative  
 16 because it fails to provide the perspective of dentists who are not affiliated with  
 17 Glidewell.

18 Even if Dr. Goldstein's untimely expert opinion is considered (and it  
 19 should not be), it fails to establish that BruxZir is suggestive. Dr. Goldstein  
 20 states that “dentists would be able to identify the material in the product—  
 21 zirconia—through the use of “Zir” as the second half of the name BruxZir.”  
 22 (App. Evid., Ex. O, ¶ 17). Dr. Goldstein thus agrees that dentists would  
 23 immediately understand that “Zir” means zirconia, without imagination or  
 24 multistage reasoning. He also agrees that “Brux” causes dentists to think of  
 25 bruxism. (*Id.*) Dr. Goldstein does not state that he requires imagination or  
 26 multistage reasoning to recognize that “BruxZir” indicates a zirconia crown for  
 27 bruxers. Tellingly, even the untimely declarations of Glidewell's own dentist-  
 28 customers do not dispute this fact. (App. Evid., Exs. A-F & Q). Glidewell's in-

1 house dentist, Dr. DiTolla (whose expert designation was also untimely), admits  
2 that the terms bruxer and bruxism are taught in dental school, and Dr. Goldstein  
3 likewise knows that dentists recognize the term immediately. (Keating SOF  
4 DOC #087-1 ¶ 5; App. Evid., Ex. O ¶ 14).

5 Dr. Eggleston, Keating's expert witness and a practicing prosthodontist  
6 immediately understands a BruxZir crown to indicate a zirconia crown for  
7 treating bruxers. (Eggleston Decl., Ex. 66 at 3; Eggleston Decl., Ex. 65 at 14-  
8 16). Glidewell's own witnesses testified repeatedly that Glidewell chose the  
9 name "BruxZir" because dentists would know immediately what it means. Jim  
10 Shuck, who actually conceived of the mark, said:

11 "That's why we picked the name, because it told dentists to  
12 maximize the benefit of strength, if you see brux or you identify  
13 somebody with brux or bruxism, think of zirconium. So we put  
14 brux and zir together."

15 (Keating DOC #087-1 SOF ¶ 31).

16 Mr. Friebauer, (Glidewell's Director of R&D) testified: "To me, it stands  
17 for bruxism and zirconia. It makes sense to me." (Keating DOC #087-1 SOF ¶  
18 31). Dr. DiTolla testified: "The name BruxZir talks about the function of the  
19 crown and not the esthetics." (Keating SOF ¶ 33). Dr. DiTolla further testified:  
20 "So, I liked it, thought it was clever because of the "zir" for "zirconia"; that the  
21 dentist was going to know what was in there." (Keating DOC #087-1 SOF ¶  
22 34).

23 Glidewell admitted in its responses to Keating's Requests for Admissions  
24 that the mark "BruxZir" was, at least in part, adopted to connote a product  
25 useful for bruxers and that it is composed of zirconia. (Keating SOF DOC  
26 #087-1 ¶ 38).

27 Glidewell's argument that its crowns can also be used on non-bruxer  
28 patients is also meritless. A mark is classified as merely descriptive if it

describes one of the characteristics of the goods, including the intended user. It does not have to describe every possible user. See *Lahoti v. VeriCheck, Inc.*, 586 F.3d 1190, 1201 (9th Cir. 2009); 2 McCarthy, 4<sup>th</sup> ed. § 11:16.

**2. The Evidence Establishes Competitors Do In Fact Use Brux And Bruxer And Have A Competitive Need To Do So**

Contrary to Glidewell's claims, the evidence shows that not only do Glidewell's competitors need to use the terms brux and bruxer, they actually use the terms currently. Glidewell points to Drake's mark "ZIR-CAST" as a competitive product. (Opp at 19-20). Even this single example actually does use half of the mark—"Zir". Moreover, Glidewell ignores the evidence of widespread competitors' use of brux, bruxer and zir, even those to which Glidewell itself sent cease and desist letters. (Keating SOF DOC #087-1 ¶ 60-63; Jankowski Decl. DOC #91, Ex. 44; Eggleston Decl. DOC #93, Ex. 66 at 3-7; Ex. 107). Keating has also submitted a declaration from a third party dental lab unaffiliated with Glidewell or Keating, Showcase Dental Laboratory, that also receives (and fills) orders from dentist-customers who write "BruxZir" on prescription forms as a generic reference to an all-zirconia crown. (See Frattura Decl., ¶¶ 6-9, 18). Keating has also submitted substantial evidence showing widespread third party use of the terms "bruxer" and "brux" in connection with dental crowns. (Keating SOF DOC #087-1 ¶¶ 60-62; Jankowski Decl. DOC #91, Ex. 41; Eggleston Decl. DOC #93, Ex. 65 at 16-18; Ex. 66 at 3-7; Ex. 107).

The evidence establishes that Glidewell's competitors do indeed need and use "brux," "bruxer" and "zir" to describe their own products.<sup>5</sup>

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<sup>5</sup> Such third party descriptive use is acknowledged by Glidewell in their Opposition to Keating's Motion for Summary Judgment of Noninfringement stating that the use of "Bruxer" in reference to a zirconia crown "is used descriptively to refer to a full zirconia crown that could be used for a patient with bruxism rather than in a trademark sense." (DOC. #113 at 8.) Glidewell acknowledges multiple examples of this descriptive use. (*Id.* at 7-8.)

1 **H. Glidewell Has Not Presented Any Admissible Evidence Of Secondary**  
 2 **Meaning**

3 Glidewell has submitted no survey to rebut Keating's genericness and  
 4 descriptiveness evidence. Glidewell's employee declarations are not  
 5 sufficiently probative to meet Glidewell's burdens on summary judgment, its  
 6 untimely expert rebuttal reports and declarations are inadmissible, and the  
 7 declarations of previously undisclosed dentist witnesses/Glidewell customers  
 8 are also inadmissible. By contrast, Keating has submitted extensive undisputed  
 9 and timely evidence showing the generic use by dentists and dental labs of  
 10 "brux" and "zir as well as generic use of "bruxer" and "bruxzir" in connection  
 11 with dental crowns and users of such crowns.

12 **1. Glidewell Has Not Submitted Any Evidence Of Effect Of**  
 13 **Advertising On Consumers**

14 Although not required, survey evidence has become "de rigueur" in cases  
 15 involving genericness of trademarks. *In Hyuk Suh v. Choon Sik Yang*, 987 F.  
 16 Supp. 783, 791 (N.D. Cal. 1997). The absence of a survey from Glidewell,  
 17 particularly in view of Glidewell's financial ability to conduct a survey, raises  
 18 the inference that such a survey would not have been favorable to Glidewell.  
 19 *See Playboy Enters. V. Netscape Commc'ns Corp.*, 55 F. Supp. 2d 1070, 1084  
 20 (C.D. Cal. 1999); *Cairns v. Franklin Mint Co.*, 24 F. Supp. 2d 1013, 1041-42  
 21 (C.D. Cal. 1998).

22 In the absence of a survey, Glidewell heavily relies on evidence of its  
 23 sales and advertising. However, such evidence is only relevant if it can be  
 24 shown to have affected the connection of the mark in the mind of the consumer.  
 25 "Naturally, a 'large expenditure of money does not in itself create legally  
 26 protectable rights.'" Secondary meaning is established by how effective the  
 27 effort to create it has been. *CG Roxane*, 569 F. Supp. 2d at 1031 ("[P]laintiff's  
 28 advertisements do not emphasize the mark as a distinct way to identify the

1 producer of the product, which would be very difficult considering the mark's  
 2 widespread use in the industry”) (citing *Carter-Wallace, Inc. v. Procter &*  
 3 *Gamble Co.*, 434 F.2d 794, 800-02 (9th Cir. 1970)); *Cont’l Lab. Prods. v.*  
 4 *Medax Int’l*, 114 F. Supp. 2d 992, 1002-03 (S.D. Cal. 2000) (“Popularity of a  
 5 product is not synonymous with secondary meaning.”); *see also First Brands*  
 6 *Corp. v. Fred Meyer, Inc.*, 809 F.2d 1378, 1383 (9th Cir. 1987) (plaintiff’s  
 7 advertising, although extensive, did not emphasize the mark in such a way as to  
 8 support an inference of secondary meaning).

9 Glidewell has failed to offer the required evidence of a connection in the  
 10 mind of the consumer because it simply does not exist.

## 11 **2. Undisclosed Dentist Witness Testimony Is Inadmissible**

12 Glidewell relies upon declarations of seven dentists (Opp. p. 8, 16, 23-24;  
 13 SUF 13-14, 32-35, 55, 59), all Glidewell customers (App. Evid. Exs. A-F & Q),  
 14 at least one of whom has recently toured Glidewell’s facility (App. Evid. Ex. B).  
 15 None of these witness names were disclosed to Keating during discovery.  
 16 Glidewell has offered no excuse for its failure to disclose the witness names, nor  
 17 for its legal expert Professor Franklyn’s failure to disclose them in his expert  
 18 report or during his deposition. Accordingly, for this and other reasons stated in  
 19 Keating’s Objections to Evidence, the dentists’ testimony is inadmissible,  
 20 particularly in view of the Court’s denial of Glidewell’s *Ex Parte* Application to  
 21 extend discovery.

22 In any event, the dentists’ testimony is based on their existing relationship  
 23 with Glidewell and is therefore not persuasive evidence that a significant  
 24 number of consumers have formed a similar mental association. *Japan*  
 25 *Telecom*, 287 F.3d at 874-75.

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1           **3.     Length & Manner of Glidewell’s Use Disproves Secondary**  
 2                   **Meaning**

3           Being first to market with a product does not render the product’s name  
 4     distinctive. *See In re Phoseon Tech. Inc.*, 103 U.S.P.Q. 2d (BNA) 1822 (TTAB  
 5     2012). Secondary meaning must be established through evidence existing at the  
 6     time the alleged infringer began using the allegedly infringing mark. *Sand Hill*  
 7     *Advisors, LLC v. Sand Hill Advisors, LLC*, 680 F. Supp. 2d 1107, 1117 (N.D.  
 8     Cal. 2010) (citing *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1358  
 9     (9th Cir. 1985)).

10          At the time Keating began selling its KDZ Bruxer product in May 2011,  
 11     Glidewell had used the BRUXZIR mark for less than two years. Moreover, in  
 12     this very short time, numerous third parties were already using the terms “brux,”  
 13     “zir,” “bruxer” and “bruxzir” in connection with all zirconia crowns. This short  
 14     period, coupled with evidence of third party use, establishes that Glidewell did  
 15     not develop any appreciable secondary meaning. *See e.g., Nartron Corp.*, 305  
 16     F.3d at 405.

17           **4.     Glidewell’s Use of The Mark Was Not Exclusive**

18          Glidewell relies on the Franklyn declaration for the statement that  
 19     “BruxZir mark does not exist in a crowded field of similar marks.” (Opp. p.  
 20     25). This statement is contrary to the overwhelming evidence. Even if  
 21     admissible (which is denied), Professor Franklyn’s declaration ignores the  
 22     undisputed evidence of widespread third party use and registration of marks  
 23     including “brux,” “zir” and “bruxer” and “bruxzir”. He also ignored the  
 24     evidence of phonetic equivalence of the mark BruxZir with bruxer, the intended  
 25     user of Glidewell’s crowns. At his deposition, Professor Franklyn testified that  
 26     he had no dental industry experience, had not read any dental industry journals  
 27     and had never spoken to a dentist in connection with this case. (*see* Objections  
 28     to Franklyn Evidence submitted herewith; 2nd Jankowski Decl., Ex. 153).



1 Professor Franklyn is improperly attempting to “tailor the field” in a way that is  
 2 strategically advantageous to Glidewell. *See Halo Mgmt., LLC v. Interland,*  
 3 *Inc.*, 308 F. Supp. 2d 1019, 1034 (N.D. Cal. 2003).

4 Glidewell’s reliance on its cease and desist communications for evidence of  
 5 secondary meaning is also misplaced (Opp. at 25). Those communications state  
 6 that “BRUXZIR and BRUXER sound the same.” (Keating SOF DOC #087-1 ¶  
 7 52). The undisputed evidence establishes that Glidewell’s use of its mark has not  
 8 been exclusive.

9 **5. The Evidence Establishes Keating Did Not Copy Glidewell’s**  
 10 **Mark**

11 Keating has provided uncontested evidence as to the rationale behind Mr.  
 12 Keating’s choice of “KDZ Bruxer”. (Keating SOF DOC #087-1 ¶¶ 79-80)  
 13 Keating had been marketing zirconia based crowns under the term KDZ, which  
 14 stands for Keating Dental Zirconia, since 2006. (Keating Decl. ¶ 12; Mangum  
 15 Decl., Ex. 53 (Brandon Dep. Tr.), 20:15-16; 26:21-27:4; 38:10-12). Because the  
 16 new all-zirconia crown was specifically designed to replace gold crowns for  
 17 bruxer patients, Mr. Keating wanted to call the new crown the “KDZ Bruxer.”  
 18 (Keating SOF DOC #087-1 ¶ 80). He sought advice of counsel as to the  
 19 availability of the mark “KDZ Bruxer” and, after a trademark search, was  
 20 informed that it was. This evidence of good faith is unrebutted, and a simple  
 21 comparison of the KDZ Bruxer mark with Glidewell’s BruxZir mark, as used in  
 22 the marketplace, exposes the weakness of Glidewell’s copying argument.

23 **III. CONCLUSION**

24 For the reasons set forth above and in Keating’s opening brief, Keating  
 25 respectfully requests that the Court grant its motion in its entirety.

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Respectfully submitted,  
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: December 3, 2012

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